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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/994,987	11/06/2001	Stephane Petit	01646/TL	9112
1933	7590	11/14/2005	EXAMINER	
FRISHAUF, HOLTZ, GOODMAN & CHICK, PC 220 5TH AVE FL 16 NEW YORK, NY 10001-7708			CHANG, JULIAN	
			ART UNIT	PAPER NUMBER
			2152	
DATE MAILED: 11/14/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 09/994,987	<b>Applicant(s)</b> PETIT ET AL.	
	<b>Examiner</b> Julian Chang	<b>Art Unit</b> 2152	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 November 2001.
- 2a) ☐ This action is FINAL.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 November 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All    b) ☐ Some \* c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>02/25/2002</u> . | 6) <input type="checkbox"/> Other: _____  |

### DETAILED ACTION

1. Claims 1-13 have been examined.

#### ***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 2, 3, 5, 9, 10, 11 are rejected under 35 U.S.C. 102(b) as being anticipated by Stimson, et al (U.S. 5,721,768).
3. Regarding claim 1, Stimson, et al teach a method comprising the steps of creating a plurality of identifiers ('each authorized card has a security number associated therewith for enabling a host computer to track usage', col. 2, lines 16-21), associating each one of said identifiers with at least one of the goods and services of a merchant ('The pre-paid cards may then be used to purchase various goods and services up to the authorized dollar amount', col. 3, lines 9-11), distributing to customers tickets to which one of said identifiers has been applied ('each authorized card has a security number associated therewith for enabling a host computer to track usage', col. 2, lines 16-21), and authorizing access to at least one of said goods and services in

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recognition of one of said identifiers on said tickets ('facilitates point-of-sale activation of cards using data terminals connectible to the host computer', col. 2, lines 1-4).

4. Regarding claim 2, Stimson, et al further teach a method comprising the step of updating a database ('activating the particular pre-paid calling card account in the database', col. 8, lines 9-14) that contains, for each merchant, the goods and services ('The host computer includes a data base for storing security numbers associated with authorized purchased cards and enables users to purchase goods and services up to authorized dollar amounts using the authorized pre-paid cards', col. 3, lines 17-21) that said merchant offers, and the forms of subscription to said merchant's goods and services ('use status of each card in the system', col. 2, lines 25-30. Stimson, et al teaches two forms of subscription: account balance - 'pre-paid card may then be used to purchase various goods and services up to the authorized dollar amount', col. 3, lines 9-11'; and expiration - 'stale cards, i.e., cards that have been sold but not used or reauthorized for a predetermined time period', col. 2, lines 20-25).

5. Regarding claim 3, Stimson, et al further teach a method comprising the step of associating a ticket category with a form of subscription ('use status of each card in the system', col. 2, lines 25-30. Stimson, et al teaches two forms of subscription: account balance - 'pre-paid card may then be used to purchase various goods and services up to the authorized dollar amount', col. 3, lines 9-11'; and expiration - 'stale cards, i.e.,

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cards that have been sold but not used or reauthorized for a predetermined time period', col. 2, lines 20-25).

6. Regarding claim 5, Stimson, et al further teach a method, wherein tickets are distributed via a distribution network with which the merchant is associated ('the pre-paid calling card account being associated with a distributor of the particular pre-paid calling card account', col. 8, lines 49-52).

7. Regarding claim 9, the claim differs from claim 1 only by statutory category and is thus rejected under the same reasoning as claim 1 above.

8. Regarding claim 10, the claim differs from claim 2 only by statutory category and is thus rejected under the same reasoning as claim 2 above.

9. Regarding claim 11, the claim differs from claim 3 only by statutory category and is thus rejected under the same reasoning as claim 3 above.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

10. Claim 13 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stimson, et al as applied to claim 9 above, and further in view of what was well known in the art at the time of the invention.

11. Regarding claim 13, Stimson, et al teach the invention substantially as claimed and described in claim 9 above, but does not expressly teach a kiosk wherein the computer network is the Internet. However, Examiner takes Official Notice that the use of the Internet as a computer network in computer systems is conventional and well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to use the Internet to interconnect the different devices in the system of Stimson, et al in order to interconnect the devices over a wide area.

12. Claim 4, 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Stimson, et al as applied to claim 1 above, and further in view of Berger, et al (U.S. Patent 5,850,446).

13. Regarding claim 4, Stimson, et al teach the invention substantially as claimed and described in claim 1 above, but fail to teach a method wherein the merchant is compensated for the sale of pre-paid cards. However, Berger, et al teach a system wherein the merchant is compensated for the sale of goods ('Payment capture is the process that triggers the movement of funds from the financial institution to the

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merchant's account after settlement of the account', col. 15, lines 12-15). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the merchant compensation system of Berger, et al with the pre-paid card system of Stimson, et al in order allow a kiosk to sell goods and services from a plurality of merchants from one location.

14. Regarding claim 7, Stimson, et al teach the invention substantially as claimed and described in claim 1 above including eliminating expired tickets from the system, but fail to teach an electronic wallet in which a customer can enter multiple pre-paid cards. However, Berger, et al teach a system wherein an electronic wallet is used to keep track of payment cards ('this payment instrument holder will contain the following information. Payment instrument information including card number and expiration date', col. 140, lines 37-47). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the electronic wallet taught by Berger, et al with the pre-paid card system of Stimson, et al in order attract customers with easy and secure access to pre-paid cards (Berger, et al: col. 137, lines 51-56).

15. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stimson, et al as applied to claim 1 above, and further in view of Nair, et al (U.S. Patent 5,362,952).

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16. Regarding claim 6, Stimson, et al teach the invention substantially as claimed and described in claim 1 above, but fail to teach a method wherein the merchant pays a fee for the services provided by the kiosk. However, Nair, et al teach a card transaction terminal which charges a lower fee for merchants using electronic authorization (col. 2, lines 30-32). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the card transaction terminal taught by Nair, et al with the pre-paid card system of Stimson, et al in order to lower costs and offer affordability to low volume merchants (Nair, et al: col. 4, lines 19-26).

17. Claim 8 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stimson, et al as applied to claim 1 above, and further in view of Cameron, et al (U.S. Patent 5,592,378).

18. Regarding claim 8, Stimson, et al teach the invention substantially as claimed and described in claim 1 above, but fail to teach distributing prepaid cards to a customer free of charge with the purchase of goods and services. However, Cameron, et al teach a system of dispensing promotional items, including coupons and discounts, as part of a purchase ('Such promotions may include product-to-product cross sell, free gifts, dollar of percentage off a line item, the order, the shipping or handling coupons, a gift, a coupon, a discount, a payment type discount, a shipment service level discount, and a shipping and handling discount. They are typically driven by order and customer characteristics. Order characteristics may include total dollar amount, total line item,



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line quantity, and payment method to name a few', col. 20, lines 7-18). It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the promotional system taught by Cameron, et al with the pre-paid card system of Stimson, et al in order to promote customer loyalty.

19. Claim 12 is rejected under 35 U.S.C. 103(a) as being unpatentable over Stimson, et al as applied to claim 9 above and further in view of Berger, et al (U.S. Patent 5,850,446), and Mueller, et al (U.S. Patent 5,235,509).

20. Regarding claim 12, Stimson, et al teach the invention substantially as claimed and described in claim 9 above, but fail to teach displaying a login page upon access of the system, and placing advertisement space on the page. However, Berger, et al teach a system wherein a login page is displayed upon access of the system (Berger, et al: Figure 31). Mueller, et al teach a kiosk wherein advertisement is displayed while the kiosk is idle ('display information messages or advertisements', col. 12, lines 10-13). It would have been obvious to one of ordinary skill in the art at the time of the invention to employ the login page of Berger, et al in the kiosk of Stimson, et al in order to control access to the kiosk. It would have been obvious to one of ordinary skill in the art at the time of the invention to combine the use of advertisements taught by Mueller, et al with the kiosk of Stimson, et al in order to generate more revenue.

***Conclusion***

21. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- a. U.S. Patent 5,224,162 – Electronic cash system.
- b. U.S. Patent 5,777,305 – Activating prepaid debit cards.
- c. U.S. Patent 5,762,376 – Prepaid transaction instrument.
- d. U.S. Patent 5,791,991 – Interactive consumer promotion match game.
- e. U.S. Patent 4,307,900 – Promotional coupon device.
- f. U.S. Patent 5,637,845 – Prepaid card encoding/dispensing machine.

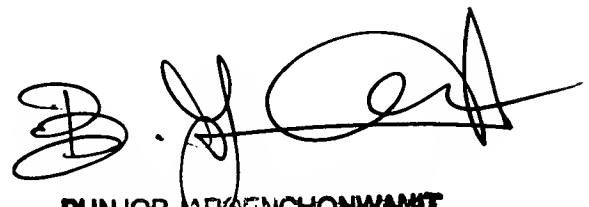
22. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Julian Chang whose telephone number is (571) 272-8631. The examiner can normally be reached on Monday thru Friday 8am to 4pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Bunjob Jaroenchonwanit can be reached on (571) 272-3913. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

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**BUNJOR ARPENCHONWANIT**  
**PRIMARY EXAMINER**